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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,900	01/28/2002	Secondo Dottori	218041US0CONT	3021

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EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/055,900

Applicant(s)
Dottori

Examiner
Sandra Saucier

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-66 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 28, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 57-66 are pending and are considered on the merits.

Claim Rejections – 35 USC § 112

INDEFINITE

Claims 58, 59, 63 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the concentration limitations in the claims are the final concentrations of carnitine in the platelet concentrate or merely an intermediate concentration such as a stock solution concentration.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 57-66 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Sweeney *et al.* [U].

The claims are directed to a method comprising:
adding L-carnitine or an ester of carnitine to a platelet concentrate to form a mixture and suspending the platelet concentrate in the mixture.

The intent of the claimed methods is the suppression of bacterial growth or reduction of glycolysis in the platelet concentrate.

The references are relied upon as explained below.

Sweeney *et al.* disclose a method of adding L-carnitine or acetyl-carnitine (5mM) to platelet concentrates and agitating the mixture. This is said to reduce glycolysis in the platelet mixture.

Although the intent of applicant's method is different from the intent of the disclosed method, the subject of the method (platelet concentrate), the one step of adding carnitine or an ester of carnitine in the same concentration are all the same. Thus, the results of the method, suppression of bacterial growth,

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would reasonably be assumed to be the same as the result claimed.

It is not relevant to the analysis of the claimed method that the reference makes no mention of suppressing bacterial growth. Discovery of a new benefit for an old process does not render the old process patentable. *In re Woodruff*, 919 F. 2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Merely because the reference did not have one of applicant's purposes in mind when the (drug was administered) does not alter the drug's physiological activity. In the context of an anticipation rejection, the Federal Circuit stated, "Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results." *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F. 3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999).

See also *In re Cruciferous Sprout* 64 USPQ2d 1202 Fed. Circuit, where the Federal Circuit upheld a decision that patents licensed to Brassica Protection Products, Inc. are invalid because they are anticipated by the prior art. The patents are for method of growing and eating certain sprouts to reduce the level of carcinogens in animals, thereby reducing the risk of developing cancer. Prior art references disclose growing and eating those specific sprouts. The Federal Circuit cited authority for the rule that "a prior art reference may anticipate when the claim limitations not expressly found in the that reference are nonetheless inherent in it." The court said, "While Brassica may have recognized something quite interesting about those sprouts, it simply has not invented anything new."

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57–66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweeney *et al.* [U] in combination with US 5,747,536 [A]

The claims are directed to the addition of esters of carnitine to a blood platelet concentrate.

The references are relied upon as explained below.

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Sweeney *et al.* has been explained above.

US 5,747,536 discloses that esters of carnitine other than acetyl ester are known.

The substitution of other esters of carnitine such as butyryl, valeryl, propionyl, isobutyryl for the acetyl ester of carnitine in the method of Sweeney *et al.* would have been obvious when US 5,747,536 was taken with Sweeney *et al.* because US 5,747,536 lists various esters of carnitine and also further discloses the addition of carnitine or its derivatives to platelet concentrates. In the absence of evidence to the contrary, the salts and esters of L-carnitine would reasonably be expected to have a similar activity to L-carnitine or acetylcarnitine.

One of ordinary skill in the art would have been motivated at the time of invention to make this substitution in order to obtain the results as suggested by the references with a reasonable expectation of success. The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. **Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198.** The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier
Primary Examiner
Art Unit 1651
July 9, 2003